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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,518	02/20/2001	Peter Balogh	P 277121 2000123US	5357
909 7590 12/27/2006 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER SHINGLES, KRISTIE D	
			ART UNIT 2141	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 09/785,518	Applicant(s) BALOGH, PETER	
	Examiner Kristie Shingles	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7-10, 13-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-10, 13-16 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

*Per Applicant's Request for Continued Examination*

*Claims 1, 5, 8, 14, 21 and 22 have been amended.*

*Claims 4, 6, 11, 12, 17 and 18 have been cancelled.*

*Claims 1-3, 5, 7-10, 13-16 and 19-22 are pending.*

### *Continued Examination Under 37 CFR 1.114*

I. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/25/2006 has been entered.

### *Response to Arguments*

II. Applicant's arguments with respect to claims 1, 8 and 14 have been considered but are moot in view of the new ground(s) of rejection.

### *Double Patenting*

III. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

Art Unit: 2141

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**IV. Claims 1, 2, 8, 9, 14 and 15 are rejected on the ground of nonstatutory double patenting over claim claims 1, 5-9, 13, 20 and 21 of U.S. Patent No. 6,870,822—since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

**V. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:**

- a method and terminal for accessing a wireless local area network in a telecommunications system, the system including at least one terminal and a plurality of networks, the method comprising: storing information sets describing settings used to access wireless local area networks and their associated resources;
- scanning/checking for information related to the names of available wireless local area networks using the terminal;
- collecting information about available the wireless local area networks and comparing the information related to the names of the available wireless local area networks to the stored information sets;
- selecting at least one wireless local area network in order to access and establish a connection to at least one wireless local area network based on settings described in an available information set.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

VII. **Claims 1-3, 5, 7-10, 13-16 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bridges et al* (USPN 6,148,197) in view of *Sainton et al* (USPN 6,934,558).**

a. Per claim 1, *Bridges et al* teach a method for accessing a wireless local area network in a telecommunications system, the system including at least one terminal and a plurality of networks, the method comprising:

- storing information sets describing settings used to access wireless local area networks and their associated resources (col.3 lines 35-49, col.5 lines 19-27, col.5 line 50-col.6 line 3);
- scanning for information related to names of available wireless local area networks using the terminal (col.3 lines 35-49, col.6 lines 25-52, col.8 lines 40-61);
- determining available information sets by comparing the information related to names of available wireless local area networks to the stored information sets (col.5 line 50-col.6 line 16, col.6 line 65-col.7 line 43), and

- accessing at least one wireless local area network based on settings described in the available information set (col.5 line 64-col.6 line 46).

*Bridges et al* teach comparing stored network names to the information related to names of available networks (col.12 lines 20-66, col.13 lines 4-50, col.16 lines 53-63). However, *Sainton et al* explicitly teach wherein the storing stores network names of networks associated with the stored information sets, the scanning sends network identity requests and searches for network identity responses, and the determining available information sets determines the available information sets by comparing the stored network names to the scanned information related to names of available networks (col.18 lines 28-36, col.19 lines 19-31 and 34-50, col.20 lines 10-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Bridges et al* with *Sainton et al* for the purpose of provisioning storing, scanning/checking, and determination means for accessing the selected available wireless local area network capable of fulfilling the user's request based on a comparison with other available wireless LANs; because this allows for the user's device to have access to comparative data regarding the different wireless LANs in order to best determine which provider better suits the user's service needs.

b. **Claims 8 and 14** contain limitations that are substantially equivalent to claim 1 and are therefore rejected under the same basis.

c. **Per claim 2**, *Bridges et al* with *Sainton et al* teach the method of claim 1, further comprising: informing a user of the terminal about the available information sets (*Bridges et al*: col.5 lines 50-63; *Sainton et al*: col.18 lines 28-36, col.19 lines 19-31, col.20 lines 12-20); receiving a user's selection of one of the available information sets (*Bridges et al*: col.5 line 64-col.6 line 24; *Sainton et al*: col.20 lines 39-41); and accessing at least one network based on the settings described in the available information set selected by the user (*Bridges et al*: col.6 lines 4-65, col.6 line 65-col.7 line 27; *Sainton et al*: col.20 lines 41-44).

d. **Claims 9 and 15** are substantially similar to claim 2 and are therefore rejected under the same basis.

e. **Per claim 3**, *Bridges et al* with *Sainton et al* teach the method of claim 1, *Bridges et al* further teach wherein the stored information sets are stored separately for each network on a smart card (col.6 lines 57-65, col.7 lines 30-43, col.11 lines 16-38, col.12 lines 28-66).

f. **Claims 10 and 16** are substantially similar to claim 3 and are therefore rejected under the same basis.

g. **Per claim 5**, *Bridges et al* with *Sainton et al* teach the method of claim 1 further comprising: *Bridges et al* further teach storing network identifiers representing a group of network names using wildcard characters in the stored information sets (col.29 lines 29-55); and determining the available information sets by comparing the stored network identifiers to the scanned information related to names of available wireless local area networks (col.29 lines 29-36).

h. **Per claim 7**, *Bridges et al* with *Sainton et al* teach the method of claim 1, *Bridges et al* further teach wherein the stored information sets comprise channel settings indicating whether at least one of (i) a used radio channel is automatically or manually selected (col.6 lines 19-24); and (ii) whether the stored information sets comprise operation mode settings indicating whether a used operation mode is an ad-hoc mode or an infrastructure mode (col.3 lines 35-49, col.6 line 65-col.7 line 5, col.8 line 50-col.9 line 10).

i. **Claims 13 and 19** are substantially similar to claim 7 and are therefore rejected under the same basis.

j. **Per claim 20**, *Bridges et al* with *Sainton et al* teach the method of claim 1, *Bridges et al* further teach wherein the information set comprises at least one of the following: DHCP (Dynamic Host Control Protocol) settings, TCP/IP (Transport Control Protocol/Internet Protocol) settings, Proxy settings, or domain logon and work-group settings (col.13 lines 56-60, Table 2).

k. **Claims 21 and 22** substantially similar to claim 20 and are therefore rejected under the same basis.

#### *Conclusion*

VIII. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure: Dunn et al (6,591,103), Bridges et al (7,096,015), Reece et al (5,915,214), Vazvan et al (6,400,946), Hronek (6,564,055).



Art Unit: 2141


IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kristie Shingles*  
*Examiner*  
*Art Unit 2141*

*kds*

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER